UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/273,021	03/19/1999	HAROLD W. MILTON JR.	MILT.777	6459

```
          7590          05/25/2007
HAROLD W. MILTON JR.
2430 WINDBROOK RUN
BLOOMFIELD HILLS, MI 48304
```

EXAMINER
RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
2176	

MAIL DATE	DELIVERY MODE
05/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

MAILED

MAY 2 5 2007

Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/273,021
Filing Date: March 19, 1999
Appellant(s): MILTON, HAROLD W.

Harold W. Milton, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 March 2007 appealing from the Office

action mailed 28 June 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,049,811	PETRUZZI	4-2000
5,754,840	RIVETTE	5-1998
5,774,833	NEWMAN	6-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 21, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi et al. (Patent # 6,049,811) in view of Rivette et al. (Patent # 5,754,840).

Regarding claims 1, 21, 26, Petruzzi teaches a *method of preparing patent application with a computer* (See col. 2, lines 33-35, wherein a computer based patent application drafting is taught)

Storing a document template in a computer program which contains headings equivalent to "Background of invention, field of invention, description of prior art, summary of invention, Brief description of drawings, Detailed description, claims and abstract" (See col. 3, lines 13-18 and lines 26-32, wherein Petruzzi teaches storing the information in computer and drafting application using various sections including claims, summary, detailed description, etc.)

Storing a page break immediately before the claims heading in the computer program and before the abstract heading (See col. 8, lines 4-7, wherein Petruzzi specifically teaches inserting a page break when needed. Petruzzi also teaches accessing MPEP rules as described in col. 6, lines 10-15. MPEP rules clearly instruct presenting abstract and claims on separate pages. Therefore user would have been aware of inserting page break before particular section)

Storing a footer in the computer program for displaying the attorney file identification on

every page of the application (See col. 16, lines 30-33, wherein Petruzzi teaches storing

footer as claimed)

Composing by a user an independent claim in the computer program ending in a clause

beginning with the words "characterized by" and reciting and isolating the patentable

novelty and preceded by at least one clause reciting prior art elements to the extent

necessary to support and provide antecedent basis for the "characterized by" clause

(See col. 12, lines 45-53, wherein Petruzzi teaches composing independent claims with

clause such as "comprising" or "comprising the steps" that have similar effect as of

claimed clause of "characterized by". MPEP clearly states that claims should be drafted

with necessary support and must provide for antecedent basis. Petruzzi also teaches

accessing MPEP rules as described in col. 6, lines 10-15)

Composing a user claims in the computer program ultimately dependant upon the

independent claim for successively more specifically defining the patentable novelty

(See col. 13, lines 14-27, wherein Petruzzi teaches the claimed invention of composing

dependant claims by adding clause "further comprising". MPEP states that dependant

claims further define patentable novelty. Petruzzi also teaches accessing MPEP rules

as described in col. 6, lines 10-15)

Characterized by storing duplicate set of all of the claims in the computer program, and

creating the description by retrieving the duplicate set of claims under the heading

"Description of preferred embodiment" (See col. 15, lines 25-30, wherein Petruzzi

teaches the claimed limitation of copying the claims to summary which is part of

specification. Also as described in col. 16, lines 10-15, Petruzzi provides for a

comparison of words in claims to detailed description and remind of missing words that

provides for the basis of copying the claims in the Detailed description) *searching for*

each occurrence of the word "said" in the duplicate set of claims copied into the

specification and replacing the word "said" with word "the" in the specification (See col.

13, lines 50-55, wherein Petruzzi teaches replacing "said" with "the" as claimed) *editing*

the claims into grammatically correct sentence structure including adding verbs (col. 5,

lines 64-col. 8, lines 8, Wherein Petruzzi teaches conventional spell check and

conventional editing. Grammatical check is also conventionally used in word

processing. Also see col. 16, lines 28-34. Also as described above Petruzzi teaches

replacing "said" with "the" as described in col. 13, lines 50-55, that in effect add verb

and makes grammatically correct structure)

Petruzzi teaches a drawings section and figures section as shown in fig 3, element 80

and 140. However Petruzzi specifically fails to teach *assigning reference numerals for*

the first time by the steps of storing the element names of the elements in the order

recited in the duplicate set of claims, storing successive numbers beginning with a

number above the highest Figure number to identify the respective element names, and

searching for each occurrence of each respective element name in the order of

occurrence in the duplicate set of claims, replacing each respective element name

with that respective element name followed by successive ones of said numbers to

provide identifying reference numerals for the element names in the order of occurrence

in the duplicate set of claims and automatically shifting the reference numerals in

response to changing the order of occurrence in the duplicate set of claims

In same field of endeavor, Rivette et al. does. Specifically Rivette et al. teaches

assigning reference numerals for the first time by the steps of storing the element

names of the elements beginning with a number above the highest Figure number to

identify the respective element names, (See col. 1, lines 59-63, col. 14, 38-41 and also

see table 1, col. 7, lines 55-col. 8, lines 7) and searching for each occurrence of each

respective element name in the order of occurrence in the duplicate set of claims, (col.

14, lines 60-col. 15, lines 4) replacing each respective element name with that

respective element name followed by successive ones of said numbers to provide

identifying reference numerals for the element names in the order of occurrence in the

duplicate set of claims (See col. 16, lines 28-60, wherein Rivette teaches a method of

allowing user to identify the reference numbers and modify the element name. Word

processor locate reference number and text or element name can be inserted next to

reference numbers as described in col. 16, lines 47-52. Since the reference numbers

are identified and modified with element name, it would also shift the reference

numerals if order of occurrence changes as claimed because element name is inserted

next to reference numbers and since each occurrence of element is searched based on

element number as described in col. 14, lines 60-col. 15, lines 10. the sequence of

elements may change or have changed. In such a situation, the reference numerals for

a given element will automatically change. Therefore every occurrence of reference

number will be replaced by reference element as claimed.

Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate Rivette's method of editing reference numbers with element name and comparing it with specification in the method of Petruzzi because it provides user with ease of determining whether consistent terminology exists in a document and for enabling user to easily modify the document so as to achieve consistent terminology.

Regarding claims 3, 22, Petruzzi teaches the claimed invention of storing duplicate set of claims under heading "summary" and editing the claims into grammatically correct sentence structure including changing "said" to "the". (See col. 15, lines 25-30, wherein Petruzzi teaches the claimed limitation of copying the claims to summary that is part of specification. Also see col. 13, lines 50-55, wherein Petruzzi teaches replacing "said" with "the" as claimed. Further in col. 5, lines 64-col. 8, lines 8, Wherein Petruzzi teaches conventional spell check and conventional editing. Grammatical check is also conventionally used in word processing. Also see col. 16, lines 28-34. Also as described above Petruzzi teaches replacing "said" with "the" as described in col. 13, lines 50-55, that in effect add verb and makes grammatically correct structure).

Claims 10, 19, 20, 23, 24, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi et al. (Patent # 6,049,811) in view of Rivette et al. (Patent # 5,754,840) as applied to claim 1 above, and further in view of Newman. (Patent # 5,774,883).

Regarding claims 10, 24, 25, 28, Combination of Petruzzi and Rivette teaches the claimed invention as described above with respect to claim 1. However Petruzzi and Rivette fails to teach searching and replacing reference numerals in claims and abstract within parenthesis

( ). However, Newman teaches verifying the abstract and verifying that the reference numerals are within parenthesis as described in col. 13, lines 39-45. It is obvious that verification must be performed by searching reference numerals and then verifying if they are in parenthesis.

It would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate analyzing method of Newman in the method of Petruzzi and Rivette because it aids in drafting patent application according to MPEP rules.

Regarding claims 19, 20, 23 and 27, Petruzzi, Rivette and Newman teaches claimed limitations as described above with respect to claim 1 and 10. As per additional limitations Petruzzi teaches *storing figure paragraph under the heading Brief description of the drawings* (See col. 14, lines 65-67. Since Petruzzi teaches adding phrases and clauses as discussed above with respect to claim 1 above, it is obvious that one ordinary skill in the art can insert and store claim terminal paragraph because it would provide drafting as per MPEP rules).

It would have been obvious for a person with ordinary skill in the art at the time the

invention was made to incorporate Rivette's method of editing reference numbers with

element name and comparing it with specification in the method of Petruzzi because it

provides user with ease of determining whether consistent terminology exists in a

document and for enabling user to easily modify the document so as to achieve

consistent terminology.

Similarly, It would have been obvious for a person with ordinary skill in the art at the

time the invention was made to incorporate analyzing method of Newman in the method

of Petruzzi and Rivette because it aids in drafting patent application according to MPEP

rules.

(10) Response to Argument

Appellant argues that Petruzzi in combination with Rivette fails to teach the

creation of a patent application. The Office respectfully disagrees. Petruzzi teaches a

machine for drafting, or creating, patent applications (See Petruzzi, Title, and Column 2,

lines 33-35), including a toolbar with an icon allowing the user to create a new

document (See Petruzzi, Column 8, lines 39-41).

Appellant argues that Petruzzi in combination with Rivette fails to teach the order

and re-order of reference numerals after copying claims. The Office respectfully

disagrees. Rivette teaches an order of occurrence of elements in the description

including assigning numerals in the order of the first recitation of the element in an

edited duplicate set of claims that created the description (See Rivette, Column 1, lines

59-63, Column 14, lines 38-41, and Table 1 in Columns 7-8). Rivette further teaches

searching for each occurrence of the respective element name in order of occurrence in

the duplicate, or copy, set of claims, such as allowing a user to identify the reference

number and modify the element name (See Rivette, Column 14, line 60 through Column

15, line 4). Rivette also notes that word processors locate reference number and text

or element names can be inserted next to reference numbers by the user (See Rivette,

Column 16, lines 47-52). Rivette also teaches that the reference numbers would

automatically shift if the order of occurrence changes as claimed because an element

name is inserted next to a reference number, such as was known when numbering lines

or entries in a word processing document, and since each occurrence of an element is

searched based on the element number (See Rivette, Column 14, line 60 through

Column 15, line 10).

Appellant argues that Petruzzi in combination with Rivette fails to teach copying

claims into the description. The Office respectfully disagrees. Petruzzi teaches copying

the claims to summary, which is part of specification of the patent application, such as

generating a first draft of the summary that includes a paragraph corresponding to each

independent claim from the Claims section (See Petruzzi, Column 15, lines 25-30).

Petruzzi also teaches a comparison of words in claims to detailed description and

remind of missing words that provides for the basis of copying the claims in the detailed

description (See Petruzzi, Column 16, lines 10-15).

Appellant argues that Petruzzi in combination with Rivette fails to teach the automatic shift of reference numerals. The Office respectfully disagrees. As described above, Rivette teaches an order of occurrence of elements in the description including assigning numerals in the order of the first recitation of the element in an edited duplicate set of claims that created the description (See Rivette, Column 1, lines 59-63, Column 14, lines 38-41, and Table 1 in Columns 7-8). Rivette further teaches searching for each occurrence of the respective element name in order of occurrence in the duplicate, or copy, set of claims, such as allowing a user to identify the reference number and modify the element name (See Rivette, Column 14, line 60 through Column 15, line 4). Rivette also notes that word processors locate reference number and text or element names can be inserted next to reference numbers by the user (See Rivette, Column 16, lines 47-52). Rivette also teaches that the reference numbers would automatically shift if the order of occurrence changes as claimed because an element name is inserted next to a reference number, such as was known when numbering lines or entries in a word processing document, and since each occurrence of an element is searched based on the element number (See Rivette, Column 14, line 60 through Column 15, line 10).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

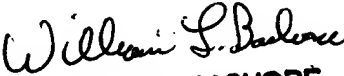For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Laurie Ries

Conferees:

William Bashore

WILLIAM BASHORE
PRIMARY EXAMINER

Stephen Hong

STEPHEN HONG
SUPERVISORY PATENT EXAMINER